



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,610	03/29/2004	Brett Allison Taylor	104558-300	9705
30873	7590	01/18/2011		
DORSEY & WHITNEY LLP			EXAMINER	
INTELLECTUAL PROPERTY DEPARTMENT			PRONE, CHRISTOPHER D	
250 PARK AVENUE			ART UNIT	
NEW YORK, NY 10177			PAPER NUMBER	
			3738	
			MAIL DATE	
			DELIVERY MODE	
			01/18/2011	
			PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/810,610

Applicant(s)

TAYLOR, BRETT ALLISON

Examiner

CHRISTOPHER D. PRONE

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,6-8,10-19,21-26,28,29,31,34,36-38,40,41 and 46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,6-8,10-16,25,26,28,29,31,34,36-38,40,41 and 46 is/are rejected.
- 7) ☒ Claim(s) 17-19 and 21-24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-913)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/24/10 has been entered.

Priority Date

The priority date of this application is its filing date 3/29/04.

Status of claims

Claims 4, 5, 9, 20, 27, 30, 32, 33, 35, 39, and 42-45 are cancelled.

Claims 1-3, 6-8, 10-19, 21-26, 28, 29, 31, 34, 36-38, 40, 41, and 46-53 are pending.

Claim Rejections - 35 USC § 112

The 112 rejections have been withdrawn.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 6-8, 10-16, 25, 36-38, 40, and 46-53 are rejected under 35 U.S.C. 103 as being unpatentable over Berry et al. USPN 2005/0060034 A1 in view of Marino et al (Marino) USPN 2004/0133278 A1 and Beaurain et al (Beaurain) WO 02/089701.

Berry discloses the invention substantially as claimed being a vertebral prosthesis shown in figure 9b comprising a first support member 22, a second support member 122, and a third support member 22 that allow for rotational and pivotal movements along an anterior, posterior and lateral axis, and first and second articulation members 30 comprising first 72 and second portions 104. Berry further discloses the support portions comprise a tapered projection portion 34 that forms a pivotal engagement with a first articulation portion 36. In regards to claims 36-38 Berry discloses that the components can be made from a variety of materials including radiopaque metals and radiolucent polymers. Berry further discloses that different members can be made of different materials which is being considered to read upon having radiopaque inserts.

However, Berry does not disclose that the articulation members comprise first and second portions that are in direct contact with each other, articulate with respect to

separate support members, and translate about a portion between the articulation portions.

Marino teaches the use of a spinal prosthesis that comprises an articulation member comprising two articulation portions that can rotate with respect to each other in the same field of endeavor for the purpose of restoring the natural rotational movement of the spine.

Beaurain teaches the use of a spinal prosthesis that comprises a pair of support members that are connected by a articulation member comprising two articulation portions comprising a central portion that allows the articulations portions to translate between the articulation portions in the same field of endeavor for the purpose of restoring the natural translation movement of the spine.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the articulation portion 30 of Berry to comprising a pair of separately translatable portions as taught by Marino and to be centrally translatable as taught by Beaurain in order to restore the patient's natural spinal movements.

Claims 26, 28, 29, 31, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Berry as modified by Bearurain and Marino as applied to claims 1-3, 6-8, 10-16, 25, 36-38, 40, and 46 above, and further in view of Gill et al. USPN 6,113,637.

Berry as modified by Bearurain and Marino discloses the invention substantially as claimed being described supra. However, the combination does not disclose that the support members comprise a fastener mount having a diagonally mounted opening.

Gill teaches the use of a spinal prosthesis that comprises fastener mount having a diagonally mounted opening for receiving a fastener in the same field of endeavor for the purpose of securing the implant to the spine.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the support members of Berry to include the fastener mount having a diagonally mounted opening as taught by Gill in order to secure the implant in place.

Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Berry as modified by Bearurain, Marino, and Gill as applied to claims 26, 28, 29, 31, and 34 above, and further in view of Johnson et al USPN 2002/0183761 A1.

Berry as modified by Erickson and Gill discloses the invention substantially as claimed being described supra. However, the combination does not disclose that the support members comprise a biologically active substance.

Johnson discloses an arthroplasty prosthesis that can deliver a biologically active substance to the implant site [0097].

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the support members of Berry to include a biologically

active substance as taught by Johnson in order to aid with the bodies healing and acceptance of the implant.

Allowable Subject Matter

Claims 17-19 and 21-24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

Applicant's arguments with respect to all claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER D. PRONE whose telephone number is (571) 272-6085. The examiner can normally be reached on Monday through Fri 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Christopher D Prone
Examiner
Art Unit 3738

/Christopher D Prone/

/Corrine M McDermott/
Supervisory Patent Examiner, Art Unit 3738